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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/674,852      | 12/14/2000  | Axel Schamal         | 225/49355           | 5694             |

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CROWELL & MORING LLP  
INTELLECTUAL PROPERTY GROUP  
P.O. BOX 14300  
WASHINGTON, DC 20044-4300

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| EXAMINER |
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REIS, TRAVIS M

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| ART UNIT | PAPER NUMBER |
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2859

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 02/23/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/674,852             | SCHAMAL, AXEL       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Travis M. Reis         | 2859                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6, & 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosken (U.S. Patent 4265002) in view of Poupitch (U.S. Patent 2650516).

Hosken discloses a device for magnetically fastening articles, comprising a post (29) for fitting into the hole (5) in the body parts (2, 4) for gripping them together (Figures 1-3), and an attachment element which is releasably connectable (25, 27) to the post (Figure 1), with the post fitted into the hole, rest on a surface of the body part (Figure 3) surrounding the hole, wherein the attachment element has a shell (10) made of nonmagnetic material (col. 3 lines 32-33) and a magnetic insert (30) precisely arranged within the shell for holding said attachment element on said body part, wherein a lower edge of the shell bears substantially flush against a lower side of the insert (Figures 2 & 3). Furthermore, the placement of the device on an article, by virtue of its existence, determines the position of a hole. Moreover, "for determining the position of or for measuring a hole in a body part of a motor vehicle" is part of the preamble only; and the preamble of the claim does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Hosken does not disclose the post is a spike; the shell has an essentially hemispherical

Art Unit: 2859

or partially spherical shape.

Poupitch discloses a dash liner clip (20) in which articles are secured to the floor or dash panels of the vehicle (col. 1 lines 10-13); wherein said dash liner clips have a partially spherical head (26) (Figures 1 & 2) and the inserted end (30) is pointed (Figure 1 & 3) forming a spike since Webster's dictionary defines a spike as "a long thick pointed piece of wood or metal". Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to shape the head of the device disclosed by Hosken in a partially spherical shape in order that the shell does not jut out from the body but is smooth, smaller and unobtrusive and does not catch on other articles and to shape the post with a pointed end in order to be more easily inserted into the hole. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. for fitting into the hole in the body part of the motor vehicle) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 ( 1987 ).

3. Claims 3 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosken & Poupitch as applied to claims 1 & 6 above, and further in view of Hall (U.S. Patent 2419134).

Hosken & Poupitch do not disclose the spike has an upper part with a screw thread which is adapted to pass through the insert and be screwed to the inside of the shell.

Hall discloses a locator (1) utilizable in forming metal articles with a shell section (6a) with interior screw threads (7) for accepting a threaded connector (61) to secure the shell to the connector (col. 2 line 22-24) (Figures 1 & 3). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the screw thread disclosed by Hall to the upper part of the spike and the interior of the shell disclosed by Hosken & Poupitch in order that the shell is securely held to the attachment element & spike.

Art Unit: 2859

4. Claims 5 & 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Hosken, Poupitch, & Hall as applied to claims 3 & 4 above, and further in view of Le (U.S. Patent 4789287).

Ham, Poupitch, & Hall disclose all of the instant claimed invention as stated above in the rejection of claims 1, 3, 4, & 6, but do not disclose expressly a spike fastened to the attachment element in an asymmetrical manner with respect thereto.

Le discloses a through bolt (3) with an asymmetric head (7) to allow fastening in otherwise inaccessible locations (Figures 1-5)(Abstract). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to make the attachment element taught by Ham, Poupitch, & Hall asymmetrical as taught by Le, thereby receiving the spike in an asymmetrical manner in order that the device could provide fastening in otherwise inaccessible locations.

### ***Response to Arguments***

5. In response to applicant's arguments that the Hosken reference is not suitable for determining the location of a hole in a metallic component or body part; these arguments have been fully considered but they are not persuasive since this is a part of the preamble and it is the combination of Hosken with the teachings of Poupitch applied which meet the limitations in the body of the claims, as detailed above in paragraph 2.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., locating holes in a precise manner) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. In response to applicant's arguments that a second set of magnets and second fastening

Art Unit: 2859

member renders Hosken unsuitable for use in the rejection; these arguments have been fully considered but they are not persuasive since additional features of the reference do not preclude Hosken, in combination with the teachings of Poupitch, from meeting the limitations of the magnetic attachment means (i.e. magnetic insert 30) holding the spike in the hole by magnetic attraction forces between the magnetic insert and the motor vehicle body part, as detailed above in paragraph 2. Since the second set of magnets and second fastening member do not interfere with this operation, their presence in Hosken is irrelevant to meeting the claims of the invention.

8. In response to applicant's argument that there is no suggestion to combine the references (i.e. Hosken & Poupitch), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the advantageous features of a smooth, smaller and unobtrusive shell as taught by Poupitch are sufficient motivation to enact a change in shape of the shell disclosed by Hosken.

9. In response to applicant's arguments that Hosken is modified by Poupitch in order to "fit snugly" and therefore would destroy the reference being able to easily be undone; these arguments have been fully considered but they are not persuasive since "to fit snugly" is not the motivation to modify Hosken. The Poupitch reference is only used to teach a smooth, smaller and unobtrusive shell and this teaching only modifies the shell disclosed by Hosken, as detailed above in paragraph 2.

10. In response to applicant's arguments that Poupitch fails to teach the magnetic attaching

Art Unit: 2859

means holding the spike in the hole; these arguments have been fully considered but they are not persuasive since these limitations are already met by the Hosken reference, as detailed above in paragraph 2.

11. In response to applicant's arguments that Hall fails to teach the magnetic attaching means holding the spike in the hole; these arguments have been fully considered but they are not persuasive since these limitations are already met by the Hosken reference, as detailed above in paragraph 3.

12. In response to applicant's argument that there is no suggestion to combine the references (i.e. Hosken, Poupitch, & Hall), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the advantageous features of a secure attachment of the shell to the spike as taught by Hall to modify the invention taught by Hosken & Poupitch.

13. In response to applicant's arguments that Le fails to teach the features which are missing in Hosken, Poupitch, and Hall; these arguments have been fully considered but they are not persuasive Le teaches the feature of a spike fastened to the attachment element in an asymmetrical manner with respect thereto, as detailed above in paragraph 4.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS

Art Unit: 2859

from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M. Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Travis M Reis  
Examiner  
Art Unit 2859

tmr  
February 12, 2007



Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800